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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,713	10/02/2003	Daniel M. Martelli	1200212R	9171
35227	7590	01/03/2006		
POLYONE CORPORATION 33587 WALKER ROAD AVON LAKE, OH 44012			EXAMINER CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,713

Applicant(s)

MARTELLI, DANIEL M.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 1-14 are pending in the application, claims 11 and 12 are withdrawn from consideration.
2. Amendments to the claims, filed on October 18, 2005, have been entered in the above-identified application.

Election/Restrictions

3. Newly amended claims 11 and 12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, 13 and 14, drawn to product, classified in class 428, subclass 141.
 - II. Claims 11 and 12, drawn to a process, classified in class 264, subclass various.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as cast molding the thermoplastic resin.
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and have acquired a separate

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status in the art because of their recognized divergent subject matter and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

7. Since applicant has received an action on the merits for the originally presented invention, e.g. the product, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 and 12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

REJECTIONS

8. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 102

9. Claims 1-4, 9, 10 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ota et al. (U.S. Patent No. 4,481,163).

Regarding Applicant's claim 1, Ota discloses a molded thermoplastic product (*col. 3, lines 24-36*) comprising an outer surface with an etched pattern (*sandblasted, rugged ground surface, col. 3, lines 59-61*) and frosted matte finish (*col. 2, lines 5-10*).

Regarding Applicant's claim 2, Ota discloses that the outer surface is located in one area of the product to provide a different matte finish appearance from the remainder of the product (*col. 2, lines 46-51*).

Regarding Applicant's claim 3, Ota discloses that the product is molded from a thermoplastic resin that is transparent, semi-transparent, or translucent (*col. 4, lines 5-22*).

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Regarding Applicant's claim 4, Ota discloses that the thermoplastic resin is polyethylene terephthalate (*col. 3 line 39*).

Regarding Applicant's claims 9 and 10, as seen in Ota's figure 2 the ratio of depressions to lands in the surface area can range from about 50 to about 80 percent.

Regarding Applicant's claim 13, Ota discloses that the product is useful at a container (*col. 1, line 12*).

Regarding Applicant's claim 14, Ota discloses that the colorant provides diffused translucency to the product and has texture (*col. 2, lines 5-21*).

Claim Rejections - 35 USC § 103

10. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota.

Ota is relied upon as described above.

Ota fails to disclose that the frost colorant is present from about 0.2 to about 5 parts by weight of the thermoplastic resin.

Ota discloses that the color tone of the product is provided as not to fairly disturb the transmission of the light rays through the product (*col. 4, lines 23-30*).

Therefore, the exact part by weight of the colorant is deemed to be a result effective variable with regard to the transmission of light, i.e. translucency. It would require routine experimentation to determine the optimum value of a result effective variable, such as parts by weight of colorant, in the absence of a showing of criticality in the claimed parts by weight. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

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Ota also fails to disclose the depth of the depressions in the etch pattern.

The exact depth of the depressions is deemed to be a result effective variable with regard to the frosted look. It would require routine experimentation to determine the optimum value of a result effective variable, such as parts by depth of depressions, in the absence of a showing of criticality in the claimed parts by weight. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

ANSWERS TO APPLICANT'S ARGUMENTS

11. Applicant's arguments in the response filed October 18, 2005 regarding the previous rejections of record have been considered but are moot due to the new grounds of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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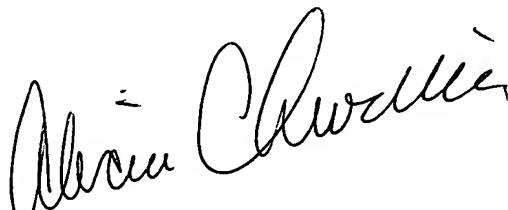
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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12/27/05


ALICIA CHEVALIER
PRIMARY EXAMINER